



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/716,397

11/20/2003

Katsuaki Akama

1086.1187

5532

21171 7590 11/25/2008  
STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

GYORFI, THOMAS A

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,397	<b>Applicant(s)</b> AKAMA, KATSUAKI	
	<b>Examiner</b> Thomas Gyorfi	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-14 remain for examination. The correspondence filed 8/18/08 amended claims 1, 2, 7, 8, 11, and 12.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teitelbaum (U.S. Patent 5,872,834) in view of "The Frequent Traveler: How to keep your phone working when in Europe" (hereinafter, "McGinnis") in view of Sanchez Herrero et al. (U.S. Patent 7,177,642).

Regarding claims 1, 7, and 11:

Teitelbaum discloses a method, program, and apparatus for registering the position of a terminal equipment, comprising: registering personal information for each user, the personal information linking a subscribed terminal number, a terminal subscriber identification number and user charging information to biological information of a user possessing the terminal equipment (col. 8, lines 64-67); receiving from the terminal equipment an authentication request containing the user biological information and the terminal subscriber authentication information (col. 7, lines

Art Unit: 2435

30-50); retrieving personal information having biological information matching the received biological information and of changing terminal subscriber information in the retrieved personal identification into the received terminal subscriber identification information (Ibid, and col. 8, lines 10-35); transferring the subscribed terminal number in the retrieved personal information and the received terminal subscriber identification information to an exchange and of requesting position information registration which enables call in and call out as a terminal equipment having the subscribed terminal number (Ibid; and col. 8, lines 50-57).

Although Teitelbaum discloses embodiments of that invention that are practicable on cellular [wireless] phones (e.g., col. 8, line 64 – col. 9, line 10; col. 12, lines 20-30; Figure 12), there appears to be no explicit teaching wherein the cell phone embodiment could be employed in the hotel embodiment cited in the claims. Nevertheless, McGinnis discloses wherein it was desirable for hotels to rent out mobile phones to their guests, prior to the instant invention (page 2, “Third-party rentals”). The claims are thus obvious because the substitution of a wireless phone as a known equivalent for the wired phone (again noting that Teitelbaum was already aware of his invention being implemented as a wireless phone) as the specific type of phone being rented by the hotel would have yielded predictable results to one of ordinary skill in the art at the time of the instant invention.

Although McGinnis discloses wherein the rental cell phone will have the same phone number as the owner's original cell phone (page 1, “Rent from your provider”) , McGinnis does not go into the requisite amount of detail to read on the new claim limitation regarding transferring the subscriber terminal number and said first terminal subscriber identification information from among said pieces of personal information to a switching center to request registration of the position

Art Unit: 2435

information which permits call in and call out of said first terminal equipment by said subscribed terminal number. However, Sanchez Herrero discloses a technique that produces the same end result as disclosed by McGinnis while including this limitation (col. 4, lines 35-67; col. 6, lines 40-50; cf. cols. 10 & 11). The claims are thus obvious because the technique of uploading a subscriber's personal information from a first cell phone to a server for subsequent transfer to a second cell phone was clearly well within the capabilities of one of ordinary skill in the art, in view of the teaching of the technique in related situations.

Regarding claims 2, 8, and 12:

Teitelbaum further discloses notifying a terminal equipment which has been used so far of renouncement of its use when the position information is requested of the exchange which enables call in and call out as a terminal equipment having the subscribed terminal number based on the authentication of biological information from a new terminal equipment by the received authentication request, retrieved personal information, and the transferred subscribed terminal number (col. 8, lines 5-11 and also lines 20-35).

Regarding claims 3, 9, and 13:

Teitelbaum further discloses wherein the biological information received by the received authentication request is biological information read in real time into the terminal equipment (e.g. col. 8, lines 40-50).

Regarding claims 4, 10, and 14:

Art Unit: 2435

Teitelbaum further discloses wherein the personal identification management step includes registering charged user identification information of a specific person among group members as common charged user identification of a plurality of terminal equipments owned by group members such that the specific person is charged (col. 8, lines 10-35).

Regarding claim 5:

Teitelbaum further discloses wherein the terminal equipment is a cellular phone (Figure 12, and col. 8, line 64 – col. 9, line 10).

Regarding claim 6:

Teitelbaum further discloses wherein the biological information is a fingerprint, venous vascular network, palm print, palm shape, facial image, ear shape, or iris (e.g. col. 4, lines 20-30).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patents 6,892,074 to Tarkiainen et al.; 6,151,503 to Chavez; and 5,943,620 to Boltz.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2435

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Gyorfi whose telephone number is (571)272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG

11/17/08

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435